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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,291	06/04/2007	Tony N. Frudakis	DNA1180-2	7164
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DLA PIPER LLP (US) 4365 EXECUTIVE DRIVE SUITE 1100 SAN DIEGO, CA 92121-2133			EXAMINER GOLDBERG, JEANINE ANNE	
			ART UNIT	PAPER NUMBER
			1634	
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			12/10/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/589,291

Applicant(s)

FRUDAKIS, TONY N.

Examiner

JEANINE A. GOLDBERG

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 4, 5 and 14-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the papers filed August 14, 2009. Currently, claims 1-28 are pending. Claims 4-5, 14-28 have been withdrawn as drawn to non-elected subject matter.

Election/Restrictions

2. Applicant's election without traverse of Group I and SEQ ID NO: 3, 4, Claims 1-3, 6-13 in the paper filed August 14, 2009 is acknowledged.

The requirement is still deemed proper and is therefore made FINAL.

Priority

3. This application is a 371 of PCT/US05/004513, filed February 11, 2005 and claims benefit of 60/544,788, filed February 13, 2004 and 60/548,370, filed February 27, 2004.

It is noted that although both elected SNPs of SEQ ID NO: 3 and 4, rs1004611 and rs1874835 are mentioned in the provisional applications, neither of the disclosures teach how to infer an eye color based upon an allele. There is no teaching which allele is associated with which eye color.

Drawings

4. The drawings are acceptable.

Claim Rejections - 35 USC § 112-Scope of Enablement

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-3, 6-13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method for detecting the SNP at nucleotide 68 of SEQ ID NO: 3 and nucleotide 171 of SEQ ID NO: 4, does not reasonably provide enablement for a method of inferring natural eye color in a human subject based upon detecting the SNP at nucleotide 68 of SEQ ID NO: 3 and nucleotide 171 of SEQ ID NO: 4.
4. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Factors to be considered in determining whether a disclosure meets the enablement requirement of 35 USC 112, first paragraph, have been described by the court in *In re Wands*, 8 USPQ2d 1400 (CA FC 1988). *Wands* states at page 1404,

"Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized by the board in *Ex parte Forman*. They include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims."

The nature of the invention and breadth of claims

The claims are drawn to method of inferring natural eye color in a human subject based upon detecting the SNP at nucleotide 68 of SEQ ID NO: 3 and nucleotide 171 of SEQ ID NO: 4.

The invention is in a class of invention which the CAFC has characterized as “the unpredictable arts such as chemistry and biology.” *Mycogen Plant Sci., Inc. v. Monsanto Co.*, 243 F.3d 1316, 1330 (Fed. Cir. 2001).

The unpredictability of the art and the state of the prior art

The art teaches the organization and sequence of the human P gene (Lee et al. *Genomics*, Vol. 26, pages 354-363, 1995). Mutations of the p gene result in type II oculocutaneous albinism (OCA2) in humans. Lee teaches the human OCA2 locus is mapped to 15q11-q13.

The OCA2 gene was formerly called the P gene.

Rebbeck et al. (*Cancer Epidemiology, Biomarkers and Prevention*, Vol. 11, pages 782-784, August 2002) teaches the p gene is an inherited biomarker of human eye color. Rebbeck teaches individuals were less likely to have blue or gray eyes if they had P gene variants (abstract). Rebbeck teaches eye color may be blue, gray, green, hazel, light brown, dark brown and black. Rebbeck use the following categories of eye color for analysis bleu/gray; green/hazel and brown/black (page 782, col. 2).

Frudakis et al. (*Genetics*, Vol. 165, pages 2071-2083, December 2003) teaches identifying numerous SNPs, haplotypes and diplotypes within OCA2, for example associated with iris color. The list of SNPs in Table 2 do not include the elected SNPs of SEQ ID NO: 3 and 4. Frudakis teaches haplotypes with 13 different SNPs that appear to be associated with various distinguishment of colors. For example sequence 1 of OCA2 distinguished blue from brown. And sequence 22 distinguishes

green from blue. There are 6 haplotypes that do not distinguish any iris colors. For haplotypes as large as 13 SNPs, there are numerous combinations that fail to provide any guidance for iris color determination.

While the state of the art and level of skill in the art with regard to the detection of any known polymorphic allele is high, the level of unpredictability in associating any particular allele with a specific phenotype is even higher. The high level of unpredictability is demonstrated by the prior art, the post filing art, and the instant specification. There is a large body of knowledge in the prior art related to polymorphisms in general, and their association with phenotypes. However, the art is highly unpredictable with regard to the functionality of polymorphic sites in genomic DNA. After a screening assay identifies polymorphisms, it is unpredictable whether any such polymorphisms would be associated with any phenotypic trait, such as a disease state, physiological state, or drug metabolism or response. Lucentini (*The Scientist*; 2004, vol 24, page 20) teaches that most gene association studies are typically wrong. Lucentini teaches that it is strikingly common for follow-up studies to find gene-disease associations wrong (left column, 3rd paragraph). Lucentini teaches that two recent studies found that typically when a finding is first published linking a given gene to a disease there is only roughly a one-third chance that the study will reliably confirm the finding (left column, 3rd paragraph). Lucentini teaches that bigger sample sizes and more family-based studies, along with revising statistical methods, should be included in the gene association studies (middle column, 1 st complete paragraph). In the instant case, the specification only provides information that the variant exists, but provides no guidance that it has any effect whatsoever on the CYP 1A1 gene, expression, or activity, let alone any potential diagnostic or therapeutic effect

The art teaches genetic variations and associations are often irreproducible.

Hirschhorn et al. (Genetics in Medicine. Vol. 4, No. 2, pages 45-61, March 2002) teaches that most reported associations are not robust. Of the 166 associations studied three or more times, only 6 have been consistently replicated. Hirschhorn *et al.* suggest a number of reasons for the irreproducibility of studies, suggesting population stratification, linkage disequilibrium, gene-gene or gene-environment interactions, and weak genetic effects and lack of power are possible factors that lead to such irreproducibility. Hirschhorn *et al.* caution that the current irreproducibility of most association studies should raise a cautionary alarm when considering their use as diagnostics and prognostics (p. 60, Col. 2). Thus, Hirschhorn cautions in drawing conclusions from a single report of an association between a genetic variant and disease susceptibility.

Additionally, Ioannidis (Nature Genetics, Vol. 29, pages 306-309, November 2001) teaches that the results of the first study correlate only modestly with subsequent research on the same association (abstract). Ioannidis teaches that both bias and genuine population diversity might explain why early association studies tend to overestimate the disease protection or predisposition conferred by a genetic polymorphism (abstract).

Guidance in the Specification.

The specification provides no evidence that the one of skill in the art could infer natural eye color of a human by detecting the SNP at nucleotide 68 of SEQ ID NO: 3 and nucleotide 171 of SEQ ID NO: 4. The specification teaches measuring iris colors with a cannon digital camera. 100 samples were collected. The specification teaches grouping the lightest 21 samples together and then grouping the darkest 21 samples together. The specification analyzes the samples for SNPs. 27 SNPs were used for

further analysis. The specification teaches classification models incorporated 32 SNPs from Table 2. Table 2 comprises the elected SNPs of SEQ ID NO: 4 and 3. SEQ ID NO: 3 is located at position 1905 and is rs1004611. SEQ ID NO: 4 is located at 1869 and is rs1874835. Table 3 lists 10 SNPs that were particularly useful for inferring eye color and indicates the eye color shade that can be drawn for a particular allele. SEQ ID NO: 3 T is listed as darker and SEQ ID NO: 4 T is listed as darker. The specification teaches darker indicates brown or hazel eyes while lighter indicates blue or green eyes (page 26). The specification teaches that iris colors of "unknown" samples based on the genotypes of 35 SNPs provided a blind classification accuracy of 97% when an exact match existed across all of the genotypes in Table 2. This seems to state that iris color could be inferred correctly 97% of the time if ALL 35 SNPs were correct. This provides no indication how to infer eye color based upon the presence of two SNPs. The guidance provided by the specification amounts to an invitation for the skilled artisan to try and follow the disclosed instructions to make and use the claimed invention.

Quantity of Experimentation

The quantity of experimentation in this area is extremely large since there is significant number of parameters which would have to be studied to allow the skilled artisan to infer natural eye color of a human by detecting the SNP at nucleotide 68 of SEQ ID NO: 3 and nucleotide 171 of SEQ ID NO: 4. The specification appears to state that for a 97% accuracy, it takes 35 SNPs to match across all genotypes. The specification does not provide any discussion of what type of accuracy one might expect with the use of only two genotypes.

Moreover, it is unclear how the skilled artisan would infer eye color in the event that nucleotide 68 of SEQ ID NO: 3 were to indicate a darker eye shade and nucleotide

171 of SEQ ID NO: 4 were to indicate a lighter eye shade. There would be no reasonable inference to be made.

Furthermore, it is unclear how one would infer natural eye color. Rebbeck teaches 7 categories of eye colors, namely blue, gray, green, hazel, light brown, dark brown and black. The specification only analyzes two categories: dark or light.

This would require significant inventive effort, with each of the many intervening steps, upon effective reduction to practice, not providing any guarantee of success in the succeeding steps.

Level of Skill in the Art

The level of skill in the art is deemed to be high.

Conclusion

In the instant case, as discussed above, in a highly unpredictable art where the association of SNPs with a particular phenotype is unpredictable, it is unclear how one could practice the claimed invention as broadly as claimed. Further, the prior art and the specification provides insufficient guidance to overcome the art recognized difficulties in association studies. Thus given the broad claims in an art whose nature is identified as unpredictable, the unpredictability of that art, the large quantity of research required to define these unpredictable variables, the lack of guidance provided in the specification, the absence of a working example and the negative teachings in the prior art balanced only against the high skill level in the art, it is the position of the examiner that it would require undue experimentation for one of skill in the art to perform the method of the claim as broadly written.

Claim Rejections - 35 USC § 112- Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-3, 6-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The claims are drawn to a method for inferring natural eye color in a human subject by detecting the SNP at nucleotide 68 of SEQ ID NO: 3 and nucleotide 171 of SEQ ID NO: 4. The final process step is merely drawn to identifying SNPs. It is unclear whether the claims are drawn to inferring natural eye color or whether the claims are merely drawn to identifying the SNP in a nucleic acid sample. The metes and bounds of the claimed invention are unclear.

Conclusion

7. **No claims allowable.**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeanine Goldberg whose telephone number is (571) 272-0743. The examiner can normally be reached Monday-Friday from 7:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Nguyen, can be reached on (571)272-0731.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Central Fax Number for official correspondence is (571) 273-8300.

/Jeanine Goldberg/

Primary Examiner

December 10, 2009